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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,952	09/26/2001	Toshihide Hida	1122.65856	1582
7590 06/23/2008 Patrick G. Burns, Esq. GREER, BURNS & CRAIN, LTD. Suite 2500 300 South Wacker Dr. Chicago, IL 60606				
EXAMINER KARMELEK, ALISON L.				
ART UNIT		PAPER NUMBER		
3623				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/963,952

Applicant(s)

HIDA, TOSHIHIDE

Examiner

ALISON KARMELEK

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9, 13-15, 19-21 and 25-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-9, 13-15, 19-21 and 25-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/06/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 16, 2008 has been entered.
2. The following is Non-Final office action in response to communications received May 16, 2008. Claims 7, 13, and 19 have been amended. Claims 7-9, 13-15, 19-21, and 25-29 are now pending in this application.

Response to Arguments

3. Applicant's arguments filed May 16, 2008 have been fully considered but they are not persuasive. In particular, Applicant argues that because of the separation of the servers of Bilbrey et al., it would not have been obvious to combine the sponsor and the network servers and thus, Bilbrey et al. fails to disclose or suggest a procedure in which the same server receives the absence response information from the client also performs the step of distributing the absence response information to the other servers. While Examiner notes that Bilbrey et al. utilizes two servers to perform these actions, Examiner also notes that it is old and well known in the art to perform actions of two independent servers on a connected network in one server on that same network, or

rather "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice." See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Furthermore, Applicants have not provided any reasoning as to why performing the networks on the one server is functionally distinguished from performing those same methods on two servers of the same network. Examiner reiterates that it is within ordinary skill in the art to consolidate such distributed processing.

4. Applicant's arguments with respect to claims 28-30 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9, 13-15, 19-21, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey et al. (U.S. 2002/0103932).

7. As per claim 7, Bilbrey et al. teaches a computer readable medium storing a program to cause a computer to perform message-address management processing in

a system capable of exchanging messages among a plurality of servers and clients, wherein the program causes a server computer to perform:

when a message address of a member of a message exchanging group is changed, absence response information including at least an old address and a new address of the member is caused to be received from the client (See paragraph 83, where updates of a recipient's address is provided. See also paragraphs 7-8, 10, 46-7, and 63-4, where a member of a group of recipients in a message system changes his/her address and this information is sent by the client to the server. See also figures 20-21, where a recipient specifies his old and new address as well as with whom this information can be shared);

determining, from a plurality of provided message address lists, lists of message exchange groups, a message address list including the old address of the member, and extracting message addresses of the rest of the members of the determined message address list, wherein the rest of the members includes members with message addresses that have not been changed (See paragraphs 58, 80, 85-9, wherein an address list is communicated and used to substantially update the "sponsors" email address list. Email addresses are received and matched against old email addresses. The members that are not the member whose address is changing are obtained and the member along with other members in the list with old addresses are obtained, and updated. See also paragraphs 55, 61, 63-4, 68);

determining a server associated with each of the rest of the members of the determined message list (See abstract, paragraphs 7, 82, 112, wherein members are

associated with a server which is located for address changes and notifications. See also paragraphs 8, 10, 46-7, 55, 59, and 85-9, where the network server has information concerning addresses and the "sponsor" interacts with this server based on the information contained in its list);

specifying a server to which the absence response information is to be provided, on the basis of the determined server or servers (See paragraphs 7-8, 10, 46-7, 55, 59, and 85-9, where the network server has information concerning address changes, and the "sponsor" interacts with this server based on the information contained in its list); and

distributing the absence response information to the specified server or servers (See paragraphs 7, 55, 59, wherein the network server and the sponsor communicate to provide and receive the information).

However, Bilbrey et al. does not expressly disclose determining domain information associated with each of the rest of the members of the determined message list or specifying a server based on the domain information and the server receiving aid the absence response information from the client also performs the step of distributing the absence response information.

Bilbrey et al. discloses a system that allows email addresses to be updated. Examiner takes official notice that domain information consists of a set of network addresses and is a name with which name server records are associated and through which resources are accessed at a number of different servers in the network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to determine domain information when determining server information associated with members in order to more efficiently locate members in the network using addresses.

Additionally, Bilbrey et al. teaches the functionality of the claim language as recite above. Examiner takes Official Notice that it is old and well known in the art to perform the functions of two independent servers on a connected network on a single server on the network, or rather "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice." See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the server which receives the information to also distribute that information in order to more efficiently perform the functions that Bilbrey et al. teaches without transferring the information between servers.

8. As per claim 8, Bilbrey et al. discloses wherein the absence response information contains a period of validity of the absence response information (See paragraphs 112 and Table 3, where the determination is made as to whether addresses are valid. See also paragraphs 61 and 68, wherein the address information is time stamped, to show the time at which the date become valid and up to date).

9. As per claim 9, Bilbrey et al. teaches wherein a plurality of pieces of the absence response information to be distributed to the same server are gathered together for distribution See paragraph 58, wherein the information to be distributed to the sponsor

is gathered together at the server for distribution to the sponsor based on the list and the Reconnection Manager).

10. Claims 13-15 recite substantially similar subject matter to claims 7-9, respectively, and are therefore rejected using the same art and rationale set forth above.

11. Claims 19-21 recite substantially similar subject matter to claims 7-9, respectively, and are therefore rejected using the same art and rationale set forth above.

12. As per claims 25-27, Bilbrey et al. discloses wherein absence response information includes a flag indicating whether the absence response information is to be provided to a mail server administrator (See paragraph 0080, wherein an indication is sent by an administrator to receive absence information (i.e. undeliverable addresses and/or all addresses)).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilbrey et al. in view of Summers (US 6,816,884 B1).

15. As per claim 28, Bilbrey et al teaches the message address list of a message exchanging group. However, Bilbrey et al. does not expressly disclose that the message addresses in the message address list exchange messages with each other. Summer teaches a message addresses in the message address list exchange messages with each other (col. 1, lines 39-50 and col. 3, lines 25-42 teach a listserver which includes a list of addresses that communicate with each other).

It would have been obvious to one of ordinary skill in the art to include in the message address management system of Bilbrey et al. the ability to apply the functions of Bilbrey et al. to the message address list of a message exchange group of message address that exchange messages with each other as taught by Summers since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same functions as it did separately. Meaning the message address management system would have performed the same functions on the message address list regardless of the type of message address list involved (i.e., sponsor list of a list server of addresses). Thus, one of ordinary skill in the art would have recognized the results of combining Bilbrey et al. and Summers as predictable.

16. Claims 28-29 recite substantially similar subject matter to claim 28, and are therefore rejected using the same art and rationale set forth above.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALISON KARMELEK whose telephone number is (571)272-1808. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALK
6/16/08
/A. K./
Examiner, Art Unit 3623

/C. Michelle Tarae/
Primary Examiner, Art Unit 3623